



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,162	02/13/2001	Kazuma Sato	862.C2116	9463

5514 7590 05/31/2005

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

SHAH, AMEE A

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,162

Applicant(s)

SATO ET AL.

Examiner

Amea A. Shah

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-16, 35-43 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 2, 4-16 and 35-43 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1, 2, 4-16, and 35-43 are pending in this action.

Response to Amendment

Applicant's amendment, filed November 8, 2004, is acknowledged and entered. Claims 1, 2, and 4-16 have been amended. Claims 3 and 17-24 have been canceled. Claims 25-34 have been withdrawn. Claims 35-43 have been added.

Response to Arguments

Applicant's arguments filed November 8, 2004, regarding the claims have been considered but are moot in view of the new ground(s) of rejection necessitated by applicant's amended claims.

Specification

The disclosure is objected to because of the following informalities: references to "LBP" are made in the specification (page 76, lines 21-23, and page 79, line 8) and in the drawings (Figs. 35 and 37), but LBP is not defined in any way so that one skilled in the relevant art can understand. Appropriate correction is required.

Examiner Notes

With reference to 32 U.S.C. 101, the examiner makes the following interpretations regarding the claims:

(1) Amended claims 1 and 7 and new claims 41 and 42 are system and method claims relating to managing plural types of maintenance agreements relating to an image forming apparatus including sections/steps for acquiring a number of printed paper sheets, storing a variety of charge amounts, calculating a payable amount, and (for claims 41 and 42) managing agreement information. While no specific technology is stated in the claims, in light of the specification, the examiner interprets these sections/steps to be comprised of or accomplished by computer hardware or software. Based on this interpretation, these claims and their dependencies are not mere abstract ideas and meet the statutory requirements of 32 U.S.C. 101.

(2) Amended claim 12 and new claim 43 are apparatus claims for computer programs stored on computer-readable mediums for calculating a charge. While the claims do not specify that the computer programs are executable by a computer or processor, in light of the specification, the examiner interprets the programs to be executable by a computer or processor. Based on this interpretation, these claims and any dependencies are not disembodied data structure claims and meet the statutory requirements of 32 U.S.C. 101.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it

Art Unit: 3625

is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Amended claims 4, 6, 9, 11, 14, and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for the recitation of the new limitations. The claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 4, 9 and 14 contain the limitation of “an accepting [section/step/code] of accepting an instruction for instructing an agreement through a window based upon information of an agreement instruction window” (claims, lines 2-3). The examiner reviewed the specification in full, and at page 76, line 18 through page 77, line 7, found:

A check box 3505 is turned on by the user to select agreement contents 25 to be changed. When the user inputs to this check box, a mark which can be identified by the user is added to the window. An instruction button 3507 is clicked to display detailed information of the agreement contents. When this instruction button is clicked, details of the agreement contents are displayed the window. To display such detailed contents, an instruction button 3307 is also displayed in Fig. 33. This allows the user to check the agreement contents in advance.

The examiner also found at page 81, lines 10-17:

Upon receiving the approval information, the service center transmits information as shown in Fig. 40 to the user site (not illustrated in the flow). This display information contains instruction button information (4005) for executing printing. When this button is clicked, printing corresponding to the display information is executed.

These sections in the specification are best understood by the examiner to refer to a selection of an agreement, but not an accepting section/step. Therefore, for examining purposes, the accepting step is considered to be the selection of an agreement by a user.

Claims 6, 11 and 16 contain the limitation of a second accepting section/step for accepting an instruction for instructing (i) a type of agreement through a window based upon information of an agreement instruction window and (ii) a period of the type of agreement (claims, lines 2-4) which has not been discussed in the specification. The examiner reviewed the specification in full, and at page 87, line 22 through page 88, line 7 found:

The user can arbitrarily select a plurality of agreement conditions such as the spot maintenance agreement, basic maintenance agreement, and comprehensive maintenance agreement through the user interfaces shown in Figs. 33, 35, and 38 in accordance with the desired maintenance form. The user can select/change the agreement conditions in units of arbitrary periods. ...

This section in the specification is best understood by the examiner to refer to a selection of an agreement for a period of time, but not an accepting section/step. Furthermore, it is not clear that this is a second and separate selection from the first selection. However, for examining purposes, the accepting step is considered to be an additional selection of an agreement by a user for a specific time period.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 10 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 5, 10 and 15 contain the limitation of “a retrieving [section/step/code] of retrieving agreement information of a most suitable agreement based upon running information of the image forming apparatus” (claims, lines 2-3). It is not clear to one skilled in the art what is meant by “a most suitable agreement” and “running information.” For

examining purposes only, the examiner will interpret “a most suitable agreement” to be an agreement that the user prefers based on “running information,” which is interpreted to mean the specifics of the printing job desired to be performed.

Claims 6, 11 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential sections/steps, such omission amounting to a gap between the sections/steps. See MPEP § 2172.01. The omitted steps are: the first accepting section/step prior to a second accepting section/step. For examination purposes only, the examiner will read claims 6, 11 and 16 to be dependencies of claims 4, 9 and 14, respectively that do contain a limitation of a first accepting section/step.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-16, and 35-43 are rejected under 35 U.S.C. 103 as being unpatentable over Farrell (US Pat. No. 5,383,129).

Referring to claim 1. Farrell discloses an information processing system for managing plural types of maintenance agreements relating to an image forming apparatus, comprising:

- an acquisition section for acquiring a number of printed paper sheets from an image forming apparatus via a communication path (Fig. 10, col. 5, lines 51-67, and col.

7, lines 28-35 – note that the number of printed paper sheets is the number of reprographic system functions and the communication path is the control section including processors for transmitting data);

- a memory for storing a variety of charge amounts per paper sheet output by the image forming apparatus in accordance with the types of maintenance agreements of a content of services by a serviceman of the image forming apparatus (col. 7, lines 35-45 and col. 8, lines 37-56 – note that the variety of charge amounts are stored depending upon the different billing rates for different functions (col. 7, lines 35-45) and upon the type of printing material (col. 8, lines 37-56) to be used in calculating the charge amount per sheet); and
- a calculation section for calculating a payable amount on the basis of (i) the number of printed paper sheets acquired by said acquisition section and (ii) a charge amount of the varied of charge amounts stored in said memory for the image forming apparatus from which the number of printed paper sheets is acquired (Fig. 11 and col. 7, lines 35-45).

Farrell does not expressly show the stored charge amounts being in accordance with the types of maintenance agreements of a content of services by a serviceman of the image forming apparatus. As analyzed above, Farrell shows the stored charge amounts in accordance with the different billing rates and types of printing materials. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the storing step recited. The storing of a variety of charges would be performed in the same manner regardless of

Art Unit: 3625

whether the charges are based on maintenance agreements, billing rates or types of printing materials. Thus, the non-functional descriptive material will not distinguish the claimed invention from the prior art Farrell in terms of patentability. *See In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowrey*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to store charges based upon any criteria, such as types of maintenance agreements, billing rates or types of printing materials, because such criteria does not functionally relate to the storing step and also because the subjective interpretation of the criteria does not patentably distinguish the claimed invention.

Referring to claim 2. Farrell further discloses the system according to claim 1,

- wherein said memory stores a first charge amount per printed sheet in correspondence with an agreement of a first type and a second charge amount per printed sheet in correspondence with an agreement of a second type (col. 8, lines 37-56 – note that the agreement of a first type is the printing material type and the agreement of the second type is the unit cost);
- wherein the contents of services under each of the agreements of the first type and the second type differ from each other (col. 8, lines 37-56 – note that the printing material type and unit cost are inherently capable of differing from each other); and

- wherein the amount of the second charge is an additional amount of the first charge and a predetermined amount (col. 8, lines 43-48 – note that the predetermined amount is the reference value).

Referring to claim 4. Farrell further discloses the system according to claim 1, further comprising:

- an acceptance section for accepting an instruction for instructing an agreement through a window based upon information of an agreement instruction window (Fig. 9 and col. 7, lines 11-17 – note that the acceptance step is the selection of requirements for the job as indicated in the Job Ticket and the agreement instruction window is the touch-screen/user-interface);
- wherein said calculation section calculates the payable amount based upon (i) a charge amount per printed sheet in accordance with the agreement instructed by the instruction accepted by said acceptance section and (ii) the number of printed sheets acquired by said acquisition section (col. 7, lines 35-45).

Referring to claim 5. Farrell further discloses the system according to claim 4, further comprising:

- a retrieval section for retrieving agreement information of a most suitable agreement based upon running information of the image forming apparatus (Fig. 11 and col. 8, line 10 through col. 9, line 13 – note that the retrieval section is step 518 which

obtains a unit cost for each printing materials type from the database and a most suitable agreement is an agreement most suitable according to the user's preferences); and

- an information section for informing a user of a result of retrieval by said retrieval section (Figs. 11 and 12 and col. 9, lines 14-29 – note the information section is step 522 wherein an invoice showing the various printing material type costs is generated and shown).

Referring to claim 6. Farrell further discloses the system according to claim 4, further comprising:

- a second acceptance section for accepting an instruction for instructing (i) a type of agreement through a window based upon information of an agreement instruction window and (ii) a period of the type of agreement (Figs. 9 and 10 and col. 8, lines 10-36 – note that the second accepting step is the selection of whether the billing is for actual or estimates based on the functions and material types chosen and the period of the agreement is the job);
- wherein said calculation section calculates the payable amount in the instructed period accepted by said second acceptance section based upon (i) a charge amount per printed sheet in accordance with the type of agreement in the instructed period and (ii) the number of printed sheets is a number of sheets printed during the instructed period (Figs. 10 and 11 and col. 8, line 37 through col. 9, line 28).

Referring to claims 7-16. All of the limitations in method claims 7-11 and apparatus claims 12-16 are closely parallel to the limitations of system claims 1, 2, and 4-6, respectively, analyzed above and are rejected on the same bases.

Referring to claim 35. Farrell further discloses the system according to Claim 1, further comprising:

- a provision section for providing an external apparatus with a section for providing information of an agreement instruction window which is readable by a web browser (Fig. 9, col. 6, lines 23-32, and col. 9, lines 14-29 – note that the provision of information to an external apparatus is the invoice displayed on the user interface display of printed and that the user interface enables the user to “program print jobs, obtain system operating information, instructions, programming information, diagnostic information, etc.” and is readable by a web browser),
- wherein said calculation section calculates the payable amount based upon (i) a charge amount per printed sheet in accordance with the agreement instructed through a display window of the external apparatus based upon the information of agreement instruction window and (ii) the number of printed sheets acquired by said acquisition section (Figs. 11 and 12 and col. 8, line 52 through col. 9, line 13).

Referring to claim 36. Farrell further discloses the system according to Claim 1, further comprising a transmitter for transmitting a window for confirming an identifier and an agreement corresponding to the identifier to the external apparatus (col. 9, lines 14-29 – note that the

transmission of information to an external apparatus is the invoice displayed on the user interface display or printed that confirms an identifier and an agreement).

Referring to claims 37-40. All of the limitations in method claims 37 and 28 and apparatus claims 39 and 40 are closely parallel to the limitations of system claims 35 and 36, respectively, analyzed above and are rejected on the same bases.

Referring to claim 41. Farrell discloses an information processing system for managing plural types of maintenance agreements relating to an image forming apparatus, comprising:

- a managing section for managing agreement information of an agreement of maintenance of the image forming apparatus by a serviceman, wherein the agreement is an agreement of a first type corresponding to a first maintenance content or an agreement of a second type corresponding to a second maintenance content (col. 7, lines 35-40 and col. 8, lines 37-47 – note that the managing step comprises the storing of various billing rates, the development of the look-up table of costs, and the maintaining of the table by updating and changing costs);
- an acquisition section for acquiring information of a number of printed sheets by the image forming apparatus via a communication path (Fig. 10 and col. 5, lines 51-67, and col. 7, lines 28-35 – note that the number of printed paper sheets is the number of reprographic system functions and the communication path is the control section including processors for transmitting data);

- a memory for storing a variety of charge amounts per paper sheet in accordance with whether the type of agreement for the image forming apparatus is the first type or the second type, in correspondence with the image forming apparatus (col. 7, lines 35-40 and col. 8, lines 37-56 – note that the variety of charge amounts is comprised of the billing rates, the printing materials costs, and the unit costs, which are stored in the look-up table); and
- a calculation section for calculating a payable amount on the basis of (i) the number of printed paper sheets acquired by said acquisition section and (ii) a charge amount stored in said memory in correspondence with the image forming apparatus (Fig. 11 and col. 7, lines 35-45 – note that the charge amount is the rate and the number of printed paper sheets is the number of printing functions performed).

Farrell does not expressly show the stored charge amounts being in accordance with the types of maintenance agreements of a content of services by a serviceman of the image forming apparatus. As analyzed above, Farrell shows the stored charge amounts in accordance with the different billing rates and types of printing materials. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the storing step recited. The storing of a variety of charges would be performed in the same manner regardless of whether the charges are based on maintenance agreements, billing rates or types of printing materials. Thus, the non-functional descriptive material will not distinguish the claimed invention from the prior art Farrell in terms of patentability. *See In re Gulack*, 703 F.2d 1381,

1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowrey*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to store charges based upon any criteria, such as types of maintenance agreements, billing rates or types of printing materials, because such criteria does not functionally relate to the storing step and also because the subjective interpretation of the criteria does not patentably distinguish the claimed invention.

Referring to claims 42- 43. All of the limitations in method claim 42 and apparatus claim 43 are similar to the limitations of system claim 41 analyzed above and are rejected similarly.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

(1) Krist et al., Patent No. 5,745,883, disclosing a billing system for use in a printing system, including configurable billing information file for a plurality of incremental billing meters (*see* columns 6-9); (2) Robinson et al., Patent No. 5,850,584, disclosing a method for determining printing job parameters based on image quality and material usage (*see* columns 3-7); (3) Lacheze et al., Patent No. 5,956,698, disclosing a method for use in a printing system in which billing is developed for the customer on the basis of accounting information accrued and stored in an accounting subsystem (*see* columns 9-14); (4) Yamaguchi, Patent No. 6,385,675 B1, disclosing a printer which operates according to several different functional and operational

modes and an accounting means which calculates charges bases on the order (*see* columns 2-6); (5) Coons et al., Patent No. 6,832,250 B1, disclosing a method and system for remotely storing usage data associated with monitored assets (*see* columns 4-9); and (6) Hiroshi et al., EP 0 429 056 A2, disclosing a centralized control system for devices such as copying machines to collect information regarding maintenance required and abnormalities (*see* pages 3-16).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAS

May 23, 2005


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600